

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: Gang Liu, *et al.*

Serial No.: 09/941,471

Filed: August 29, 2001

For: SELECTIVE PROTEIN TYROSINE
PHOSPHATASE INHIBITORS

Examiner: T. V. Oh

Group Art Unit: 1625

Case No.: 6724.US.P1

Date: March 8, 2004

Certificate of Mailing under 37 CFR §1.8(a):

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to:

Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450 on

Date of Deposit: March 8, 2004

Wanda E. Smith
Wanda E. Smith

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE (37 CFR 1.111)

Sir:

REMARKS

Claims 1-75 are currently pending. Claims 1-17 stand rejected. Applicants respectfully traverse the rejections and request reconsideration and withdrawal thereof.

In the instant Office Action mailed September 8, 2003, at sheet 3 of 4 of Applicant's Form PTO-1449, Documents C19 through C27 were not initialed by the Examiner. No reasons were provided for such. Applicants respectfully request reconsideration of the Documents C19-C27 and initialing thereof.

At page 2 of the Office Action, claims 1-9, 11, 14-19, 22, 25, 30-35, 40-44, 49, 50-52, 55-58, 61-67 and 69-75 stand WITHDRAWN from further consideration as being drawn to a non-elected invention. However, those claims also stand REJECTED as indicated on the Office Action Summary (see ¶4) and throughout the Office Action. (See, eg., pps. 4 and 6). Because withdrawn claims cannot be simultaneously rejected, Applicants respectfully request clarification and correction of the status of each pending claim.

However, in any event, Applicants submit that all claim 1-75 are in condition of allowance.

In the Office Action at pages 3-4, claims 2-75 stand provisionally rejected under 35 USC 101 over claims 2-69 and 89-94 of then co-pending Application Serial No. 10/085,157. While Applicants respectfully traverse the substantive grounds of the rejection, the rejection is not moot because the '157 application has been abandoned.

At pages 4-5 of the Office Action, claims 1-75 stand provisionally rejected as being obviousness-type double patenting over claims 1-8 and 19-23 of then co-pending Application Serial No. 09/918,928. At page 5, instant claim 1 is also provisionally rejected as being obviousness-type double patenting over claim 1 of the '157 abandoned application. Again, the rejections have become moot on the ground that the '928 and '157 applications have been abandoned. On the ground that all of the provisional rejections have become moot, Applicants respectfully request reconsideration and withdrawal.

At page 6 of the Office Action, claims 1-75 stand rejected under 35 USC 102(f). The Examiner alleges that the instant Applicants did not invent the claimed subject matter. In support thereof, the Examiner notes that the '157 applications shares the same elected specie, but that the '157 application includes 2 inventors not included in the instant application. To support that rationale, the Examiner appears to have assumed that the 2 inventors *necessarily* contributed to the elected specie in both applications. Otherwise, the rejection is unsupportable.

Applicants respectfully submit that the Examiner has erred in the assumption and that the rejection is unsupportable. Reconsideration and withdrawal of the rejection is respectfully requested.

At page 3 of the Office Action, the Specification is objected to on the ground that the headers for examples 30 and 34 are informal. Applicants respectfully traverse on the ground, inter alia, that the headers are in compliance with 35 USC 112. Applicants' fail to understand *why* the recitations are objectionable. Reconsideration and withdrawal of the objection is respectfully requested.

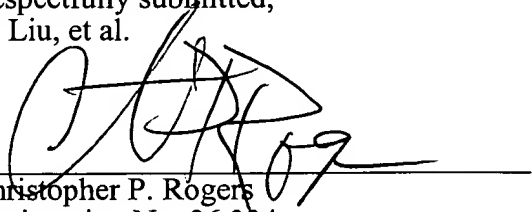
In sum, Applicants submit that the application is in condition for early allowance and respectfully solicit the same. The Examiner is invited to contact the undersigned to discuss any matter respecting the application.



23492

Abbott Laboratories
D377/AP6A-1
100 Abbott Park Road
Abbott Park, IL 60064-6008
Work Direct (847) 936-3362
Fax: (847) 938-2623

Respectfully submitted,
G. Liu, et al.



Christopher P. Rogers
Registration No. 36,334
Attorney for Applicants